

(Practitioner's Docket No. IN-5553CP/BC1-0063)

REMARKS

1. Objection to claims 3 and 9-11 and Amendment of claim 1.

Claim 3 has been objected to for use of the expression "according to Fox". Claims 9-11 have been objected for the misspelling of "resin" in claim 9. Appropriate correction has been required.

The expression "according to Fox" and the word 'arithmetic' have been removed from claim 3. It is submitted that one of skill in the art will appreciate the meaning of this term in view of paragraph [0039] of Applicants' Specification. Paragraph [0039] provides a formula whereby the glass transition temperature of the reaction product can be calculated. Those of skill in the art will appreciate that all other variables will be available for the calculation, i.e., the number of different monomers used to make the reaction product, the weight fraction of the nth monomer, and thus the characteristic glass transition temperature of the homopolymer of the nth monomer. Accordingly, entry of the amendment to claim 3 is respectfully requested.

Claim 9 has been amended to correct the misspelling of 'resin'. Entry of the amendment to claim 9 is respectfully requested.

Independent claim 1 has been amended to incorporate the limitations of dependent claim 5. Dependent claim 5 has been canceled.

Entry of the amendment to claim 1 and reconsideration and removal of the objections to claim 3 and 9-11 is respectfully requested.

2. Rejection of claims 1-12 under 35 U.S.C. §102(a) anticipated by or, in the alternative under 35 U.S.C. §103(a) as obvious over WO 00/014049 herein after "WO '049".

Claims 1-2 stand rejected as anticipated by the WO '049 reference.

Applicants appreciate the detailed basis of rejection but must respectfully disagree with the basis of rejection. In particular, Applicants respectfully submit that this reference is not available as a prior art reference with regards to the instant application.

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WO '049 is the published PCT application for PCT application PCT/EP99/06042, filed on Aug. 18, 1999. WO '049 published on March 16, 2000 with German language text.

Thus, this PCT application was not filed on or after November 29, 2000, and was not published in English. Accordingly, WO '049 is available under 102(a) or (b) only as of its publication date, i.e., March 16, 2000. Similarly, the corresponding U.S. patent (U.S. 6,515,192) is only available under 102(e) only as of its 371(c)(1), (2), (4) date of February 20, 2001 or under 102 (a) or (b) as of its issue/publication date February 4, 2003.

However, the instant application is entitled to rely upon its earliest German priority date of August 27, 1999. See *paragraph [0001] of Applicants' Specification*.

The WO '049 publication is therefore not prior art with regards to the instant application.

Reconsideration and removal of the rejections is respectfully requested.

3. Rejection of claims 1-12 under 35 U.S.C. §103(a) as obvious over WO 00/014049 herein after "049".

Claims 1-2 stand rejected as obvious by the WO '049 reference.

Applicants appreciate the detailed basis of rejection but must respectfully disagree with the basis of rejection. In particular, Applicants respectfully submit that this reference is not available as a prior art reference with regards to the instant application. In particular, the WO '049 publication is not available as a prior art reference with respect to 35 U.S.C. 103 (a) until its PCT publication date. Similarly, the U.S. patent is not available as a 102(e) reference until its 371 date or as a 102(a) or (b) reference until its U.S. issue date or its U.S. publication date.

For example, WO '049 is the published PCT application for PCT application PCT/EP99/06042, filed on Aug. 18, 1999. WO '049 published on March 16, 2000 with German language text.

Thus, this PCT application was not filed on or after November 29, 2000, and was not published in English. Accordingly, WO '049 is available under 102(a) or (b) only as of its issue/publication date, i.e., March 16, 2000. Similarly, the corresponding U.S.

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patent (U.S. 6,515,192) is only available under 102(e) only as of its 371(c)(1), (2), (4) date of February 20, 2001 or under 102 (a) or (b) as of its issue/publication date February 4, 2003.

However, the instant application is entitled to rely upon its earliest German priority date of August 27, 1999. See *paragraph [0001] of Applicants' Specification*.

The WO '049 publication is therefore not prior art with regards to the instant application.

Reconsideration and removal of the rejections is respectfully requested.

4. Rejection of claims 1-4 and 8-12 under 35 U.S.C. §102(a) anticipated by Aerts et al. WO 96/20968 herein after Aerts or "968".

Claims 1-4 and 8-12 stand rejected as anticipated by Aerts.

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree.

The invention of Applicants' amended independent claim 1 is a *method for making* a coating material. It is not a coating composition.

Rather, the claimed process requires that a mixture of olefinically unsaturated monomers be copolymerized in at least one hydroxyl-containing reactive diluent that comprises a polyol.

It is respectfully submitted that this aspect of the invention of claim 1 is neither disclosed nor suggested by Aerts.

The crux of the PTO's position appears to be that "...a portion of the hydroxyl functional monomer set forth in Aerts is also capable of acting as the reactive diluent set forth by applicant." See *Office Action of 4/27/05, paragraph 5, page 4*. Thus, the PTO suggests that a copolymerizable monomer is the same as a reactive diluent.

However, the invention of Applicants' amended claim 1 requires copolymerization of a particular monomer mixture in a reactive diluent that comprises a polyol. As recognized by the PTO, Aerts fails to disclose or suggest this required aspect of the claimed invention. To anticipate a claim, a single source must contain all of the elements of the claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986).

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Accordingly, Aerts fails to anticipate the invention set forth in Applicants' amended claim 1.

Reconsideration and removal of the anticipation rejection is respectfully requested.

5. Rejection of claims 1-4 and 8-12 under 35 U.S.C. §103(a) as obvious over Aerts et al. WO 96/20968 herein after Aerts or "968".

Claims 1-4 and 8-12 stand rejected as obvious by Aerts.

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree.

The invention of Applicants' amended independent claim 1 is a *method for making* a coating material. It is not a coating composition.

Rather, the process set forth in amended independent claim 1 requires that a mixture of olefinically unsaturated monomers be copolymerized in at least one hydroxyl-containing reactive diluent that comprises a polyol.

It is respectfully submitted that Aerts fails to provide a prima facie case of obviousness with regard to the invention of Applicants' amended independent claim 1. The Patent and Trademark Office has the burden of showing a prima facie case of obviousness. *In re Bell*, 26 U.S.P.Q.2d 1529, 1530 (Fed. Cir. 1993).

The crux of the PTO's position appears to be that "...a portion of the hydroxyl functional monomer set forth in Aerts is also capable of acting as the reactive diluent set forth by applicant." See *Office Action of 4/27/05, paragraph 5, page 4*. Thus, the PTO suggests that a copolymerizable monomer is the same as a reactive diluent.

However, the invention of Applicants' amended claim 1 requires copolymerization of a particular monomer mixture in a reactive diluent that comprises a polyol. As recognized by the PTO, Aerts fails to disclose or suggest this required aspect of the claimed invention.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

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expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

Aerts fails to satisfy this standard. In particular, Aerts fails to disclose all of the required limitations and fails to provide any motivation to modify Aerts so as to provide Applicants' claimed invention. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (C.C.P.A. 1974); MPEP 1243.03.

Accordingly, Aerts fails to anticipate the invention set forth in Applicants' amended claim 1.

Reconsideration and removal of the rejection is respectfully requested.

6. Rejection of claims 1-4 and 12 under 35 U.S.C. §102(e or b) as anticipated by each of DE19805421 and Zeller et al. US 6,274,660 (both herein after referred to as "Zeller").

Claims 1-4 and 12 stand rejected as anticipated by Zeller.

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree.

The invention of Applicants' amended independent claim 1 is a *method for making* a coating material. It is not a coating composition.

Rather, the claimed process requires that a mixture of olefinically unsaturated monomers be copolymerized in at least one hydroxyl-containing reactive diluent that comprises a polyol.

It is respectfully submitted that this aspect of the invention of claim 1 is neither disclosed nor suggested by Zeller.

The crux of the PTO's position appears to be that "...a portion of the hydroxyl functional monomer set forth in Zeller is also capable of acting as the reactive diluent set forth by applicant." See *Office Action of 4/27/05, paragraph 6, page 5*. Thus, the PTO suggests that a copolymerizable monomer is the same as a reactive diluent.

However, the invention of Applicants' amended claim 1 requires copolymerization of a particular monomer mixture in a reactive diluent that comprises a polyol. As recognized by the PTO, Zeller fails to disclose or suggest this required

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aspect of the claimed invention. To anticipate a claim, a single source must contain all of the elements of the claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986).

Accordingly, Zeller fails to anticipate the invention set forth in Applicants' amended claim 1. Similarly, Zeller also fails to anticipate the invention of dependent claims 2-4 and 12 since these claims incorporate the limitations of amended independent claim 1.

Reconsideration and removal of the anticipation rejection as to claims 1-4 and 12 is respectfully requested.

7. Rejection of claims 1-12 under 35 U.S.C. §102(e or b) as obvious over each of DE19805421 hereinafter ("421") and Zeller et al. US 6,274,660 herein after ("Zeller" or "660").

Claims 1-4 and 12 stand rejected as obvious by Zeller.

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree.

The invention of Applicants' amended independent claim 1 is a *method for making* a coating material. It is not a coating composition.

Rather, the process set forth in amended independent claim 1 requires that a mixture of olefinically unsaturated monomers be copolymerized in at least one hydroxyl-containing reactive diluent that comprises a polyol.

It is respectfully submitted that Zeller fails to provide a prima facie case of obviousness with regard to the invention of Applicants' amended independent claim 1. The Patent and Trademark Office has the burden of showing a prima facie case of obviousness. *In re Bell*, 26 U.S.P.Q.2d 1529, 1530 (Fed. Cir. 1993).

The crux of the PTO's position appears to be that "...a portion of the hydroxyl functional monomer set forth in Zeller is also capable of acting as the reactive diluent set forth by applicant." See *Office Action of 4/27/05, paragraph 6, page 5*. Thus, the PTO suggests that a copolymerizable monomer is the same as a reactive diluent.

However, the invention of Applicants' amended claim 1 requires copolymerization of a particular monomer mixture in a reactive diluent that comprises a

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polyol. As recognized by the PTO, Zeller fails to disclose or suggest this required aspect of the claimed invention.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

Zeller fails to satisfy this standard. In particular, Zeller fails to disclose all of the required limitations and fails to provide any motivation to modify Zeller so as to provide Applicants' claimed invention. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (C.C.P.A. 1974); MPEP 1243.03.

Accordingly, Zeller fails to anticipate the invention set forth in Applicants' amended claim 1. Similarly, Zeller also fails to anticipate the invention of dependent claims 2-4 and 12 since these claims incorporate the limitations of amended independent claim 1.

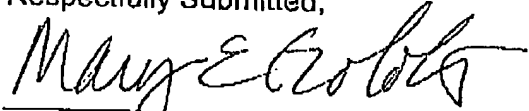
Reconsideration and removal of the obviousness rejection as to claims 1-4 and 12 is respectfully requested.

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CONCLUSION

Applicants respectfully submits that the Application and pending claims are patentable in view of the foregoing amendments and/or remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,



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